

ATTORNEY DOCKET NO. 13053STUS01U (NORT10-00100)
U.S. SERIAL NO. 09/739,708
PATENT

REMARKS

Claims 1-31 are pending in the application.

Claims 1-31 have been rejected.

Reconsideration of the Claims is respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

Claims 1-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Han, et al. (US 5,818,903 (hereinafter "Han")) in view of Alajajian (US 5,668,880). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir.

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A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Han relates to a simulation device. The Han simulation device is directed to a CDMA mobile automatic call simulating method and a simulator therefor which overcomes the problems encountered in the conventional CDMA mobile automatic call simulating method and simulator. Thus, Han is directed to a distinctly different invention in a different area (simulator and simulating methods) and not directed, or related, to receiving messages from a calling party (and sending to a called party at a determined communication address) when a synchronous call attempt is unsuccessful. Han fails to disclose, suggest, or teach the receiving of the message, or reciting the message was "composed" by a calling party.

Alajajian is directed to a wireless inter-vehicle personal communication device and local area network. See, Abstract; Col. 6, lines 30-43. Thus, Alajajian describes successful

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communications (connections or calls) between two inter-vehicle devices but fails to address responses or actions taken when the communications (connections or calls) are unsuccessful.

The Office Action argues that Alajajian discloses "receiving a message composed by the calling party; and sending said message to said determined communication address" (citing Col.7, lines 9-30; Col. 13, lines 35-44; Col. 22, lines 37-61; and Col. 24-25, lines 66-9). However, Applicant's independent Claims 1, 16 and 30 recite, after dropping the synchronous call attempt to the called party, receiving a message composed by the calling party, and sending the message to the determined communication address. See, Claims 1, 16 and 30. Alajajian recites sending a packet message (one of five types of messages) to the target party. Nothing in Alajajian describes that the message is composed by the calling party after dropping a synchronous call attempt to the called party.¹ Therefore, this element is not met by Alajajian.

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The Office Action further argues that "If one reference teaches one feature, and the other reference teaches the other feature, as long as the features are disclosed in the claim and found in the respective reference, the two references are capable of being combined and used to form a proper 35 U.S.C. 103(a) rejection." See, Office Action, page 6.² Applicant respectfully submits that the Office Action is applying an incorrect obviousness standard. As set forth above, to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

¹ In fact, Alajajian does not appear directed to synchronous call attempts.

² Applicant notes that the Office Action has not cited to any authority/regulation for the proffered standard applied by the Office Action.

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of ordinary skill in the art, to modify the reference or to combine reference teachings.

The Office Action has failed to establish a prima facie case of obviousness for at least two reasons. First, Han and Alajajian each fail to disclose receiving a message composed by a calling party after dropping a synchronous call attempt. Second, because Han and Alajajian are disparate in the subject matter of their disclosure, and because Han fails to address responses or actions taken when the communications (connections or calls) are unsuccessful, there is no motivation or suggestion to modify or combine the two reference teachings.

Accordingly, Applicant respectfully submits neither Han or Alajajian, taken alone or in combination, disclose, teach or suggest Applicant's claimed invention.³ Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-31.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

³ With respect to independent Claim 27, this claim recites that an indication (that the calling party wishes to send a message) from the calling party is detected during the synchronous call attempt. Neither reference discloses, teaches or suggests these element/feature, as recited in independent Claim 27 (and dependent claims).

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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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